

Application No. 10/722,162

### REMARKS

Claims 1 to 72 are pending in the application. Claims 1 to 5, 38 to 52, 55, 56, and 59 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schwarz et al. (U.S. Patent 5,122,187). Claims 6 to 37, 53, 54, 57, 58, and 60 to 72 have been objected to as being dependent upon a rejected base claim, and have been indicated to be allowable if rewritten in independent form.

The Examiner has rejected claims 1 to 5, 38 to 52, 55, 56, and 59 as being unpatentable over Schwarz et al. Schwarz et al. discloses hot melt ink compositions suitable for ink jet printing which comprise a colorant, a binder, and a propellant selected from the group consisting of hydrazine; cyclic amines; ureas; carboxylic acids; sulfonic acids; aldehydes; ketones; hydrocarbons; esters; phenols; amides; imides; halocarbons; urethanes; ethers; sulfones; sulfamides; sulfonamides; phosphites; phosphonates; phosphates; alkyl sulfides; alkyl acetates; and sulfur dioxide. Also disclosed are hot melt ink compositions suitable for ink jet printing which comprise a colorant, a propellant, and a binder selected from the group consisting of rosin esters; polyamides; dimer acid amides; fatty acid amides; epoxy resins; fluid paraffin waxes; fluid microcrystalline waxes; Fischer-Tropsch waxes; polyvinyl alcohol resins; polyols; cellulose esters; cellulose ethers; polyvinyl pyridine resins; fatty acids; fatty acid esters; poly sulfonamides; benzoate esters; long chain alcohols; phthalate plasticizers; citrate plasticizers; maleate plasticizers; sulfones; polyvinyl pyrrolidinone copolymers; polyvinyl pyrrolidone/polyvinyl acetate copolymers; novalac resins; natural product waxes; mixtures of linear primary alcohols and linear

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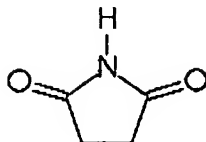
long chain amides; and mixtures of linear primary alcohols and fatty acid amides. In one embodiment, the binder comprises a liquid crystalline material.

The Examiner has stated that this reference teaches a hot melt ink comprising a colorant, binder, and propellant, that the colorant may be present in the amount of 0.5 to 10 percent by weight and may be selected from a pigment or dye, that the reference further teaches that the binder may be a polyamide, dimer acid amide, fatty acid amide which includes stearamide, stearyl erucamide, and oleamide, present in an amount of 0 to 85 percent by weight, that succinimide is disclosed as a propellant and may be present in an amount of 10 to 90 percent by weight, that the reference also teaches that the ink may be used in a thermal ink jet printer and piezoelectric drop-on-demand printer and causing droplets of the molten ink to be ejected in imagewise pattern onto a substrate, and that the fails to teach the specific succinimide set forth in claim 1. The Examiner is of the position that it would have been obvious to one of ordinary skill in the art that the succinimide taught by Schwarz et al. is broad enough to encompass polyalkylene succinimide absent evidence to the contrary, and that while Schwarz et al. fails to exemplify the use of polyalkylene succinimide, it would have been obvious to one of ordinary skill in the art to use the specific succinimide as claimed by Applicants since Schwarz et al. also discloses the use of succinimide but shows no example incorporating it.

Applicants disagree with this position. Schwarz et al. teaches a hot melt ink in which succinimide is an example of a suitable

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propellant. Succinimide is a simple monomeric compound of the formula



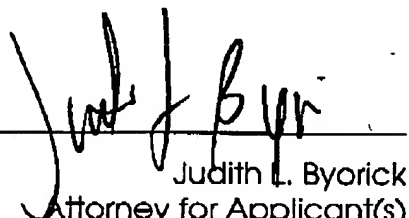
In contrast, present claim 1 recites a polyalkylene succinimide. The Examiner has pointed to nothing in Schwarz et al. that would teach or suggest to one of ordinary skill in the art that a polyalkylene succinimide would be a suitable or desirable component in a hot melt or phase change ink. Accordingly, Applicants are of the position that claims 1 to 5, 38 to 52, 55, 56, and 59 are patentable with respect to the teachings of this reference.

Applicants believe that the foregoing distinctions place the claims in condition for allowance, and accordingly respectfully request reconsideration and withdrawal of all grounds for rejection.

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In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Applicant(s) attorney, Judith L. Byorick, at Telephone Number (585) 423-4564, Rochester, New York.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Judith L. Byorick", is written over a horizontal line.

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